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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,711	11/12/2003	Guillaume Cassin	LOREAL 3.0-046; OA02360/E	9477
530 7590 06/11/2008 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				
EXAMINER				
FUBARA, BLESSING M				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/706,711

Applicant(s)

CASSIN, GUILLAUME

Examiner

BLESSING M. FUBARA

Art Unit

1618

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23, 25-35 and 37-46 is/are pending in the application.
- 4a) Of the above claim(s) 3-5 and 14-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6-13, 23, 25-35 and 37-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Examiner acknowledges receipt of amendment and remarks filed 03/03/08. Claims 24 and 36 are canceled. Claims 1, 6-8, 23, 25, 26, 33, 37, 38 and 46 are amended. Claims 1-23, 25-35 and 37-46 are pending and of these, claims 3-5 and 14-22 are withdrawn from consideration.

Response to Arguments

Previous rejections that are not reiterated herein are withdrawn.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 is directed to amphiphilic polymer that is selected from acrylic polymers, ...copolyesters. The acrylic polymer is further defined by claims 9 and 10. It is unclear how the polymers of claims 8-10 are ionic when the requirement is for the amphiphilic polymer to be ionic.

Clarification is respectfully requested.

The boundaries of AMPS derivatives in claim 8 are not defined.

Response to Arguments

3. Applicant's arguments filed 03/03/08 have been fully considered but they are not persuasive.

Applicant says that the amendment to claim 8 defining the amphiphilic polymer as being ionic overcomes the rejection. However, it is not clear how acrylic terpolymer and acrylic copolymers and polymers derived from the monomer of claim 10 are ionic. While acrylamido-methyl-propane sulfonate (AMPS) is anionic, the other polymers do not appear to be ionic.

4. Applicant has not defined the boundaries of the AMPS derivative.

It is further brought to applicant's attention that "AMPS" is abbreviation for articles other than acrylamido-methyl-propane sulfonate and an initial recitation of what the "AMPS" stands for followed by parenthetical expression of the "AMPS" would eliminate ambiguity of the abbreviated term.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 6-13, 23, 25-35 and 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubief et al. (US 6, 090,376) according to the rejections on record and reiterated herein below with slight modification to address the amendment.

Dubief discloses composition comprising at least one grafted silicone polymer in particle form dispersed in aqueous medium, amphiphilic polymer (abstract; column 1, lines 32-43; column 2, lines 21-27; column 5, lines 28-30; column 7, lines 5-7), water (column 6, line 64), vegetable, animal or synthetic oils or vitamins or surfactants (column 7, lines 8-13). The composition comprising the amphiphilic polymer, the grafted silicone polymer meeting the limitation of tensioning polymer of claim 6, water and oil meets claims 1, 2 and 33. The amphiphilic polymer is used in amounts of between 0.01 to 20 wt% (column 6, lines 59-62) and the amphiphilic polymer can be based on acrylic polymers (column 5, line 60 to column 6, line 56) with the acrylic polymers meeting claim 8-13. Exhibiting "a retraction of isolated stratum corneum ... in water is a property/characteristic of the tensioning polymer and the tensioning polymer of Dubief would have the same property/characteristic. The amended claim 1 requires that the surfactant be present at amounts of less than 1% by weight relative to the total composition and the suggestion by Dubief that the additive surfactant be preset at amounts of 0-20, with the lower limit of 0 being less than 1% suggestive that an amount of less than 1% can be used so that that limitation brought from original claim 24 into claim 1 is met. The requirement that the surfactant be different from the amphiphilic polymer is also met because, Dubief discloses composition contains amphiphilic polymer, surfactant.

Claims 11, 12 and 23, 25-32 recite the amounts of the acrylic polymer/ionic amphiphilic polymer, tensioning polymer, fatty phase, surfactant and water. Dubief does not teach the exact amounts recited in those claims. The amount of the ionic amphiphilic polymer of Dubief at 0.01 to 20 wt% (column 6, lines 59-62) encompasses the claimed amount of the ionic amphiphilic polymer or acrylic polymer. While Dubief suggests the use of additive surfactant polymer at 0-

20%, Dubief does not specifically relate the amount of the surfactant to the total weight of the composition, and while these amounts are not exactly the same as those recited in the claims, the amounts recited in the claims would have been obvious because the person of ordinary skill in the art would have good reason to use various components of the composition in amounts that would provide composition that when applied to hair would effectively treat the hair as regards entangling/disentangling and smoothness and styling and feel. In the absence of unexpected results, the amounts recited in those claims are not inventive over the teaching of Dubief.

Response to Arguments

7. Applicant's arguments filed 03/08/08 have been fully considered but they are not persuasive.

8. Applicant traverses the rejections above on the grounds that the examiner has not articulated within the legal bounds as stated in KSR, 82 USPQ 2d 1396 that the amounts of the surfactant (--the elements) recited would be rendered obvious because the person of ordinary skill in the art would have good reason to use the various components in amounts that would provide composition that when applied to hair would effectively treat the hair as it regards to entangling/disentangling and smoothness and styling and feel. The examiner disagrees. No conclusion of obviousness was made. The KSR court provided the following rationale to support finding of obviousness:

A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. See MPEP § 214.3 for a discussion of the rationales listed above along with examples illustrating how the cited rationales may be used to support a finding of obviousness.

In the present case the difference between the prior art and the claimed invention is in the %amount of the surfactant; the prior art teaches an amount of 0-20%, with the lower limit of 0% being less than 1 and meeting the recitation in claim 1 except that the art does not specifically teach the % amount is relative to the total weight of the composition. Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” In re Aller, 220 F.2d 454,

456, 105 USPQ 233, 235 (CCPA 1955). “The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages.” The amounts of the surfactant and polymer are variables and as such can be optimized for composition that would provide the anticipated feel and disentanglement of the hair and styling properties of the composition (see Dubief, column 1, lines 40-43).

Applicant argues that Dubief does not provide the rationale for the ordinary skilled artisan to formulate the hair care composition as a composition that is suitable for topical application to the skin that has a better tensioning effect than those of the prior art. The examiner disagrees because a composition that is suitable for the hair would inherently be suitable for the underlying skin upon which the hair resides. Topical application of the composition to hair would inevitably touch the skin of the scalp. Regarding the tensioning effect of the composition, it is noted that the prior art composition and the instant composition have the same grafted silicone polymers so that the polymer of the prior art would inherently have the same tensioning effect.

Applicant argues that Dubief does not teach that the presence of surfactants in an emulsion containing tensioning polymer greatly reduces the efficacy of the tensioning polymers so that the amount of surfactant is used at a minimum in order to maintain the efficacy of the tensioning polymer. This is not found persuasive because, the polymer and surfactant taught in the composition of the prior art are the same, and specifically a percent amount of 0-20% is anticipated for use in the composition of Dubief with the 0% being less than 1%. Further, it is noted that the rejection is an obviousness rejection and not one of anticipation and the artisan has

the technical skills to optimize the composition by employing surfactant and polymer in amounts that yield predictable composition that provides styling properties to the composition and good feel and disentangling to the hair.

9. Claims 1, 6 and 7 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Dubief et al. (US 6, 090,376) in view of Nandagiri et al. (US 5,362,486) according to the rejections of record and modified to address the amendment to claim 1.

Claims 1 and 6 are described above as obvious over Dubief. Dubief discloses composition comprising ionic amphiphilic polymer, tensioning polymer, water and oil as described above. The composition of Dubief is applied to the hair for treatment (abstract). The tensioning polymer of Dubief is a grafted silicone interpenetrating polymer as stated above. Dubief does not teach polyurethane and polyacrylic as tensioning polymer as recited in claim 7. However, Nandagiri discloses composition comprising polyurethane-acrylate for bodifying hair (column 15, lines 13-62). Therefore, taking the two references together, it would have been obvious to use the polyurethane-acrylate tensioning interpenetrating polymer of Nandagiri in the composition of Dubief and expect to have a composition for treating hair as it relates to body, feel, styling and disentangling of the hair.

Response to Arguments

10. Applicant's arguments filed 03/08/08 have been fully considered but they are not persuasive.

11. Applicant argues that Nandagiri teaches a composition for treating hair and not skin, that the oligomer/pre-polymers are not are not tensioning polymers such that the combination of

Dubief and Nandagiri fails to teach tensioning polymer. The examiner disagrees because the Nandagiri reference teaches in-situ polymerization of oligomers; Dubief teaches the presence of tensioning polymers except that Dubief does not teach the polymer of claim 7; hence Nandagiri is relied upon for teaching polyurethane-acrylate tensioning polymer even if the polymerization takes place in situ; the end result is a polymer.

12. Claims 1 and 43-46 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Dubief et al. (US 6, 090,376) in view of Daiko et al. (US 6,846,812) according to the rejections on record as modified below to address the amendment.

Dubief uses composition containing grafted silicone to treat hair or keratinous substances (abstract) as described above. Dubief does not teach using the composition containing grafted silicone to treating/smoothening wrinkled skin or restoring skin tautness. But composition containing grafted silicone is known to have the capability of fading out irregularities if the skin such as wrinkles and fine lines according to Daiko (column 6, lines 3, 4, 14 and 27; column 10, lines 60-62; column 11, lines 29-45; column 12, lines 50-53). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the composition of Dubief to the skin and expect the composition to smooth wrinkled skin as taught by Daiko.

Response to Arguments

13. Applicant's arguments filed 03/08/08 have been fully considered but they are not persuasive.

14. Applicant's argues that neither Daiko nor Dubief teach that the presence of surfactants reduces the efficacy of the claimed tensioning polymers. While neither Daiko nor Dubief teach the effect of surfactant on the efficacy of tensioning polymer, it is noted that same surfactants would have same effect on same polymers. Furthermore, Dubief contemplates the use of surfactant at amounts of 0-20% with the 0% being less than 1% meeting the requirement of the claims. It is therefore sufficient for one of the references in a rejection using multiple reference to teach one or more of the limitations of the examined claims and to rely on secondary references to provide what is missing in the primary references. This is the case in the current rejections under 35 USC 103. Daiko is relied upon for teaching that composition containing grafted silicone is used to treat/smoothen wrinkled skin as required by claims 43-46, so that taking the combined teachings of the prior art, one having ordinary skill in the art at the time the invention was made would have reasonable expectation of success that the composition of Dubief containing grafted silicone would effectively treat wrinkles.

Double Patenting

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

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ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 1, 2, 6-13 and 23, 25-25 and 37-46 remain provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-35; and 1-16 and 19-21 of copending Application Nos. 10982925 and 10/508007 respectively for reasons of record and reiterated herein. Although the conflicting claims are not identical, they are not patentably distinct from each other because the examined claims and the co-pending claims are concerned with compositions containing amphiphilic polymer, tensioning polymer, aqueous phase and oil phase for treating keratinous substances and for treating skin conditions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Claims 1, 2, 6-13 and 23, 25-35 and 37-46 remain provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 60-116 and 1-59 of copending Application Nos. 10/591,583 and 10/573,579 respectively for reasons of record and reiterated herein for reasons of record and reiterated herein. Although the conflicting claims are not identical, they are not patentably distinct from each other because the acrylates of the 10/591,583 and 10/573,579 applications are homologs of the acrylates of the examined claims; with the compositions of pending claims containing tensioning polymers, oil, water and surfactant for treating or softening wrinkled skin.

18. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

19. Applicant's arguments filed 03/08/08 have been fully considered but they are not persuasive.
20. Applicant believes that the provisional obviousness-type double patenting rejection is the original rejection left and request favorable consideration of the claimed invention. However, the provisional obviousness-type double patenting rejection is not the only rejection and as such the rejection is reiterated and the rejection will not be held in abeyance.
21. No claim is allowed.
22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BLESSING M. FUBARA whose telephone number is (571)272-0594. The examiner can normally be reached on 7 a.m. to 5:30 p.m. (Monday to Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Blessing M. Fubara/
Examiner, Art Unit 1618

/Michael G. Hartley/
Supervisory Patent Examiner, Art Unit 1618